

REMARKS

Claims 1-33 are pending. By this Amendment, claims 3-4, 13, and 20-21 have been amended. New claims 28-33 have been added and are presented for examination and allowance. New matter has not been added by these claims and they are generally supported by the specification, such as on pages 13-14 and 20, and by Figures 2-5 and 8-9.

**Claim Objections**

Claims 4 and 21 that were objected to because of informalities have been amended consistent with the Examiner's suggestion.

**Claim Rejections under 35 U.S.C. § 112**

Claims 3-4, 13, and 20-21 have been rejected for being in improper Markush form. Applicant respectfully submits that amended claims 3-4, 13, and 20-21 are now in proper form for allowance.

**Claim rejections under 35 U.S.C. § 103**

Claims 1-27 have been rejected as being obvious in view of U.S. Patent 6,323,483 to Cleveland et al. in combination with U.S. Patent 6,078,044 to Yasutake et al.

Applicant respectfully points out that the Cleveland et al. patent (issued November 27, 2001) does not appear to have been published prior to the filing date of U.S. Patent Application No. 09/766,055 (filed January 19, 2001), which is the parent application of the present Patent Application. As such, the Cleveland et al. patent qualifies as prior art only under one or more of subsections (e), (f) and (g) of 35 U.S.C. § 102.

Application No. 10/614,425

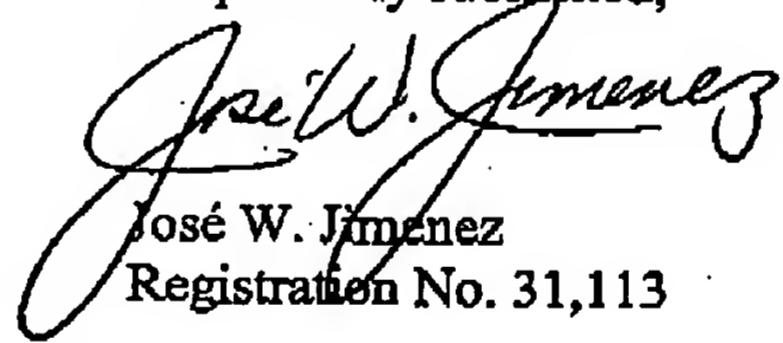
Statement establishing common ownership or an obligation for assignment to the same person or organization pursuant to § 103(c) and to MPEP § 706.02(l).

Applicant respectfully submits that the present application and the Cleveland et al. patent were, at the time the invention was made, owned by, or subject to an obligation of assignment to, Veeco Instruments Inc. Evidence of co-ownership is on page 1 of the '483 patent and on the assignment recordation (Reel/Frame 014756/0133) issued by the USPTO on June 21, 2004 (a copy is provided in Exhibit A of this Amendment and Response).

In view of the foregoing, the Cleveland et al. patent may not preclude patentability under 35 U.S.C. § 103(c) and therefore must be withdrawn as part of the references cited supporting the obviousness rejection. Since the primary reference supporting the obviousness rejection is no longer available, a *prima facie* case of obviousness can no longer be made. Therefore, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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EXHIBIT A



3025.05.05.02

**UNITED STATES PATENT AND TRADEMARK OFFICE**UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUNE 21, 2004

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JUN 25 2004

**PATTERSON, THUENTE, SKAAR  
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UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 12/04/2003

REEL/FRAME: 014756/0133  
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

## ASSIGNOR:

MASSIE, JAMES R.

DOC DATE: 10/30/2003

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SERIAL NUMBER: 10614425

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PATENT NUMBER.

TITLE: BALANCED MOMENTUM PROBE HOLDER

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